

REMARKS

The Official Action of 2 December 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 4 has been amended with the deletion of the recitation to which the Examiner objected and with the substitution of recitations previously in claim 14 (now canceled). This removes the basis for the rejection under 35 USC 112, first paragraph appearing at paragraph 6 of the Official Action.

Applicant submits herewith a terminal disclaimer to remove the basis for the double patenting rejection appearing at paragraphs 3-4 of the Official Action.

The claims stand rejected under 35 USC 103(a) as allegedly being unpatentable over Yui et al in view of WO 00/22056 (hereinafter “Hayashi”) or over this combination of references further in view of *Introduction to Physical Polymer Science* or EP 978547. Applicant respectfully traverses these rejections.

The claimed invention is based at least in part on Applicant’s finding that the claimed combination of components provides an ink that is good in printing quality, but that does not clog the nozzle of an ink jet printer. This is shown by the Examples in the specification, and in particular, Table 1 on page 48 and the text on pages 48-50.

The Examiner acknowledges that the primary reference, Yui et al, does not disclose the claimed glycol ether or 1,2-alkylene glycol, but contends that the secondary reference, Hayashi, would have motivated one of skill in the art to include these compounds in the Yui et al ink composition to form an ink with improved drying properties, improved ability to penetrate recording medium, and improved print quality. The Examiner has respectfully overlooked that a primary object of Yui et al is to provide an ink with long-term storage stability (Yui et al at column 1, lines 33-35), and that the art teaches that the inclusion of a penetrating agent, such as described in Hayashi, might adversely affect such storage stability.

In this respect, Applicant respectfully notes that Hayashi teaches the addition of polyhydric alcohol derivatives, such as diethylene glycol monobutyl ether, as a penetrating agent (Hayashi at column 5, lines 24-26), and that the art teaches that such penetrating agents can impact dispersion stability. See, US Patent 6,864,302 (copy submitted herewith) at column 2, lines 32-63 (“...when the above-described penetrant is used to improve the permeability, the dispersant adsorbed to the pigment is eliminated due to the storage shearing force upon ejection of ink through a narrow nozzle, as a result, the dispersibility is deteriorated and sometimes, the ejection becomes unstable. Furthermore, when such ink is stored for a long time of period, the pigment is liable to suffer from unstable dispersability in some cases.”). This being the case, there could have been no motivation, absent the hindsight provided by the present specification, for one of skill in the art to incorporate the penetrating agent from Hayashi into the ink of Yui et al since it would be considered that such penetrating agent could adversely affect the storage stability of the Yui et al ink.

In the absence of a motivation to combine the references as proposed by the Examiner, it is respectfully considered that the references do not set forth even a *prima facie* case of obviousness for the invention as claimed (see MPEP 706.02(j)).

In view of the above, Applicant respectfully submits that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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